



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,415	01/02/2001	Paul J. Rank	0007056-0054	3147

58328 7590 02/17/2006

SONNENSCHN NATH & ROSENTHAL LLP
FOR SUN MICROSYSTEMS
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

VAUGHN, GREGORY J

ART UNIT PAPER NUMBER

2178

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,415

Applicant(s)

RANK, PAUL J.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application Background

1. This action is responsive to the Request for Continued Examination, filed on 12/8/2005.
2. No claims were amended with this response.
3. Claims 1-16 are pending in the case, claims 1 and 9 are independent claims.
4. A request for continued examination filed under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 7/8/2005) has been withdrawn pursuant to 37 CFR 1.114.

Response to Declaration Under 37 C.F.R. 1.131

5. The applicant's declaration filed 12/8/2005 under 37 C.F.R. 1.131 has been considered but is ineffective to overcome the effective filing date of Rouse et al., US Publication 2002/0087620 (hereinafter Rouse).

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to

Art Unit: 2178

the effective date of the Rouse reference, up to the date of constructive reduction to practice (i.e. filing date of application serial number 09/754,415).

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Rouse reference to either a constructive reduction to practice or an actual reduction to practice.

The declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964). See MPEP 715.07.

In general proof of actual reduction to practice requires a showing that the apparatus or method actually existed and worked for its intended purpose. This proof is demonstrated with satisfactory evidence of facts supporting priority of invention, said proof usually in the form of exhibits. Examples of support include sketches, blueprints, photographs, reproductions of notebook entries, accompanying models, supporting statements by witnesses,

Art Unit: 2178

interference testimony, and or prior submissions to the USPTO of Disclosure documents.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). See MPEP 715.07(b).

Also, please note that an applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). See MPEP 2138.06.

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). See MPEP 2138.06.

Also, please note the diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. See MPEP 2138.06 for the nature of the showing that the attorney must make.

In view of the patent examination rules and procedures described above, the presented combination of evidence within the declaration and exhibit A

Art Unit: 2178

are insufficient proof that applicant's invention was diligently reduced to practice before the filing date of the Rouse reference, and prior to the filing date of applicant's invention.

Specifically, on page 2, paragraph 6 of the declaration, applicant claims conception of the inventive subject matter, prior to the filing date of the Rouse reference. On page 2, paragraph 7 of the declaration, applicant indicates what facts are relied upon to support the conception claim, said facts in reference to Exhibit A. On page 3, paragraph 8, applicant claims reasonable diligence "*to process the invention disclosure and prepare, execute and file the '415 application*" from the period just prior to the filing date of the Rouse reference (12/29/2000) to the filing date of applicants invention (1/2/2001). Furthermore, Exhibit A of the declaration is an Inventive Disclosure Report made by the inventor, the date and other information of said report being redacted.

However, applicant has failed to claim or indicate an actual reduction to practice of the invention in the declaration and exhibit filed. As described above actual reduction to practice requires a showing that the apparatus or method actually existed and worked for its intended purpose. This proof is demonstrated with satisfactory evidence of facts supporting priority of invention, said proof usually in the form of exhibits. Examples of support include sketches, blueprints, photographs, reproductions of notebook entries, accompanying models, supporting statements by witnesses, interference testimony, and or prior submissions to the USPTO of Disclosure documents.

Art Unit: 2178

Applicant has failed to claim or provide evidence of an actual reduction to practice. Furthermore, applicant's claim of diligence is related to the filing of the patent application, and not diligence of reduction to practice of the invention. Because applicant's declaration and exhibit lack a substantiated actual reduction to practice of the invention, the examiner must consider the invention's reduction to practice to be the date of the constructive reduction to practice (i.e. the filing date of the patent application).

Applicant has not carried the burden of showing facts or data applicant is relying on to show reduction to practice of the invention prior to the Rouse reference.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

Art Unit: 2178

7. Claims 1-16 remain rejected under 35 U.S.C. 102(e) as being anticipated by Rouse et al. US Patent publication 2002/0087620, filed 12/29/2000, published 4/4/2002 (hereinafter Rouse).
8. **Regarding independent claim 1**, Rouse discloses determining a subset of functions associated with a file from a set of functions associated with an application of the file. Rouse recites: "*Design filter 314 may validate that the design elements do not contain elements that are not needed or are not supported by the destination device (e.g., mobile device). Elements not needed may be removed and elements that are not supported may result in compile and/or other errors. Script compiler 316 may convert a subset of functions and JavaScript (or other script) to WML script (or other wireless script)*" (page 4, paragraph 44). Rouse discloses downloading the file and the subset of functions to a PDA. Rouse recites: "*Style sheet generator 318 may use XSL style sheets to generate application specific XSL style sheets that may become part of a compiled mobile application and may be used by a wireless servlet at run-time. Other types of style sheets may also be generated. Output packager 320 may store a compile output in a special mobile class. Compile output may include an application digest, style sheets and script compilation units. Other information may also be included in a compile output*" (page 4, paragraph 44). Rouse further discloses in Figure 1 at reference sign 116, a mobile server provider downloading the compile output to the wireless device (reference sign 130).

9. **Regarding dependent claim 2**, Rouse discloses determining the subset of functions based upon a user preference in Figure 2 at reference sign 216 (shown as *"User App. Preferences"*).
10. **Regarding dependent claim 3**, Rouse discloses determining the subset of functions as a family of functions Rouse recites: *"a list of possible customized replies, which may include "will discuss later", "will call later" and other replies"* (page 2, paragraph 22).
11. **Regarding dependent claim 4**, Rouse discloses displaying the subset of functions as a list. Rouse discloses a listing of the subset of functions in Figure 6, at reference sign 640.
12. **Regarding dependent claim 5**, Rouse discloses using the family of functions to recognize additional functions. Rouse recites: *"Customized replies may be predetermined for varying types of actions. For example, for a stock broker, possible replies may include "buy", "sell", "hold", etc."* (page 2, paragraph 22).
13. **Regarding dependent claim 6**, Rouse discloses a user selecting additional functions. Rouse recites: *"The mail menu screen 600 may include various viewing options which the user may select"* (page 5, paragraph 51).
14. **Regarding dependent claim 7**, Rouse discloses a family of financial functions. Rouse recites: *"For example, for a stock broker, possible replies may include "buy", "sell", "hold", etc"* (page 2, paragraph 22).

Art Unit: 2178

15. **Regarding dependent claim 8**, Rouse discloses prompting a user to choose whether to download the file and subset. Rouse recites: "*Viewing options may include enabling the user to choose which features (or lines) of a message that the user would like to make viewable*" (page 4, paragraph 49).
16. **Regarding claims 9-16**, the claims are directed toward a computer program for the method of claims 1-8, respectively, and are rejected with the same rationale.

Response to Arguments

17. Applicant's arguments filed 12/8/2005 have been fully considered but they are not persuasive.
18. Applicant's remarks are substantially directed toward applicant's submission of a declaration under 37 CFR 1.131. The declaration is ineffective to overcome the effective filing date of the Rouse reference, as described above.

Art Unit: 2178

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
February 10, 2006

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
2/15/2006